

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

BEST AVAILABLE COPY

DATE: 7-20-03

APPL. S.N.: 09/809001

EXAMINER: Elkitt

ART UNIT: 1751

PARALEGAL: DEBBIE THOMAS

MAILROOM DATE: 7-23-03

AFTER FINAL: YES ___ NO ☒

NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

☒ The T. D. is PROPER and has been recorded. (See 14.23)

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

☐ The recording fee of \$ ___ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

☐ Application Examiner has not processed fee for T. D.

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)

☐ is not recognized as an officer of the assignee. (See 14.29.1)

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

☐ The T. D. is not signed (See 14.26 and 14.26.3)

☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

☐ Other _____

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FACSIMILE TRANSMITTAL

TO

Name: Examiner E. Elhilo
Firm: USPTO Grp. Art Unit 1751
Fax No.: (703) 746-7171
Phone No.:
Date: July 23, 2003
Subject: U.S. Patent Appl'n. No. 09/809,009

FROM

Name: Maria Bautista
Phone No.: 617-452-1621
Fax # Verified by: J. Williams
Pages (incl. this): 4
Our File No.: 05727.0634

Confirmation Copy to Follow: No

If there is a problem with this transmission, notify sender at the number above.

This facsimile is intended only for the individual to whom it is addressed and may contain information that is privileged, confidential, or exempt from disclosure under applicable law. If you have received this facsimile in error, please notify the sender immediately by telephone (collect), and return the original message by first-class mail to the above address.

17
out

Attorney Docket No. 5725.0634
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean-Marc ASCIONE et al.

Group Art Unit: 1751

Application No.: 09/809,009

Examiner: E. Elhilo

Filed: March 16, 2001

For: COMPOSITIONS COMPRISING
AT LEAST TWO ANIONIC
ASSOCIATIVE POLYMERS AND
THEIR USE FOR STABILIZATION
OF AN OXIDIZING SOLUTION

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile on July 23, 2003, to Examiner Elhilo in Group 1751 at facsimile number (703) 746-7171 located at the Commissioner for Patents, Alexandria, VA 22313.


Judi Williams

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Sir:

TERMINAL DISCLAIMER

Assignee, L'ORÉAL SA, duly organized under the laws of France and having its principal place of business at 14, rue Royale, 75008 Paris, France, represents that it is the assignee of the entire right, title and interest in and to the above-identified application, Application No. 09/809,009, filed March 16, 2001 for COMPOSITIONS COMPRISING AT LEAST TWO ANIONIC ASSOCIATIVE POLYMERS AND THEIR USE FOR STABILIZATION OF AN OXIDIZING SOLUTION in the names of Jean-Marc

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Attorney Docket No. 5725.0634
Application No. 09/809,009
Customer No. 22,852

Ascione and Michael De George, as indicated by assignment duly recorded in the United States Patent and Trademark Office at Reel 012107, Frame 0019 on August 15, 2001. Assignee, L'ORÉAL SA, further represents that it is the assignee of the entire right, title and interest in and to U.S. Application No. 09/809,007, as indicated by assignment duly recorded in the United States Patent and Trademark Office at Reel 013143, Frame 0556 on July 30, 2002.

To obviate a double patenting rejection, assignee hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior patent Application No. 09/809,007, Assignee hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Assignee does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that the prior patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination

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Application No. 09/809,009
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certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916

The undersigned is an attorney of record.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 23, 2003

By: Thalia V. Warnement
Thalia V. Warnement
Reg. No. 39,064

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